NOT FOR CITATION

IN THE UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

IN RE SUBPOENAS TO ELECTRONIC FRONTIER FOUNDATION AND FRED VON LOHMANN,

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No. C 10-80276-MISC JSW

ORDER GRANTING IN PART AND DENYING IN PART EXPEDITED MOTION TO QUASH SUBPOENAS

Now before the Court for consideration is the Expedited Motion to Quash Subpoenas filed by Electronic Frontier Foundation ("EFF") and Fred von Lohmann ("Mr. von Lohmann") (collectively "Movants"). EFF and Mr. von Lohmann move to quash subpoenas issued by plaintiffs in a case pending in the United States District Court for the Southern District of New York, *Arista Records v. Lime Wire, LLC*, 06-5936 (KMW) (the "*Lime Wire* action") before Judge Kimba M. Wood. Plaintiffs in the *Lime Wire* action are thirteen major record companies (the "Plaintiffs").

On December 15, 2010, Plaintiffs filed a request to file a sur-reply. On December 16, 2010, Movants filed a response to the sur-reply. Plaintiffs' request to file a sur-reply is granted. The Court has considered the parties' papers, including the supplemental declarations ordered by the Court, the supplemental briefs submitted by the parties, Plaintiffs' sur-reply and Movants' response thereto, and relevant legal authority, and concludes that the motion is suitable for disposition without oral argument. *See* N.D. Civ. L.R. 7-1(b).

The Court also GRANTS Plaintiffs' Administrative Motions to Seal portions of their supplemental briefs. The Defendants in the *Lime Wire* action have designated those documents as confidential. If Plaintiffs wish to challenge those designations, they should do so in the *Lime Wire* action.

The Court shall not quash the subpoenas. However, it does conclude that the scope of the requests should be limited and shall modify them accordingly. Accordingly, the motion to quash is granted in part and denied in part.

BACKGROUND

In 2006, Plaintiffs filed suit against Lime Group LLC, Lime Wire, LLC, M.J.G. Lime Wire Family Limited Partnership (collectively the "Lime Wire Entities") and Mark Gorton ("Mr. Gorton") and asserted federal and state law claims of secondary copyright infringement against the Lime Wire Entities and Mr. Gorton. On May 11, 2010, Judge Wood granted in part and denied in part the parties' motions for summary judgment. (Declaration of Susan Boyd in Opposition to Expedited Motion to Quash ("Boyd Decl."), Ex. 1.)[1]

The *Lime Wire* action is now in the damages phase, and was set for trial on January 18, 2011, with the deadline to complete discovery set to close on November 24, 2010. However, on November 18, 2010, Judge Wood extended those deadlines. The deadline to complete document production now is December 29, 2010, and the parties must complete fact depositions by January 30, 2011. (*See* Notice of Extension of Discovery Deadline, Ex. A at 10.)

On or about October 27, 2010, and November 2, 2010, respectively, the Plaintiffs served Movants with deposition subpoenas and requests for production of documents. (Declaration of Matthew Scherb ("Sherb. Decl."), Exs. A, B.). Plaintiffs identify eight categories of documents or topics of testimony that, in general, pertain to communications between Movants and the Lime Wire Entities or Mr. Gorton about Lime Wire's capability of sharing copyrighted materials, the efforts - or lack thereof - taken to minimize the possibility of infringement, and the retention or destruction of documents.[2] (*Id.*, Ex. A at 2, 7-8; Ex. B at 5-6.) Plaintiffs originally requested "any document which refers to or was created during the period from January 1, 2005 through present." However, in the sur-reply brief Plaintiffs claim that they "inadvertently" listed the date as 2005, when they actually intended to request documents from January 1, 2002, through the present. (*See* Plaintiffs' Sur-Reply at 1:6-8.) In light of that error, Plaintiffs sent amended subpoenas to Movants' counsel on December 14, 2010.

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[1] Judge Wood issued an Amended Opinion in response to a letter from the EFF, in which the EFF took issue with a sentence in the opinion regarding advice that Mr. von Lohmann purportedly gave to the Lime Wire Entities and Mr. Gorton. (*See* Boyd Decl., Exs. 2 and 3.) In their response to Plaintiffs' sur-reply, Movants respond to the manner in which Plaintiffs characterize Judge Wood's original opinion and her actions thereafter. (*See* Movants' Response to Respondents' Request to File Sur-Reply and Reply at 1:3-17.)

This Court is capable of reading and interpreting Judge Wood's Orders. If the parties return to this Court, it encourages them to focus their energy on arguments that will be dispositive of the issues presented.

On November 19, 2010, the Court directed the parties to meet and confer in person to see if they could resolve their differences. The meet and confer process was unsuccessful. The Court shall address additional facts as necessary in its analysis.

ANALYSIS

A. Applicable Legal Standards.

"Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense. ... Relevant information need not be admissible a the trial if the discovery appears reasonably calculated to lead to the discovery of admissible evidence. All discovery is subject to the limitations imposed by Rule 26(b)(2)(C)."[3] Fed. R. Civ. P. 26(b)(1).[4] Rule 26(b)(2)(C), in turn, provides:

> [o]n motion or on its own, the court must limit the ... extent of discovery otherwise allowed by these rules ... if it determines that: (i) the discovery sought is unreasonably cumulative, or can be obtained for some other source that is more convenient, less burdensome, or less expensive; ... or (iii) the burden or expense of the discovery outweighs its likely benefit, considering the needs of the case, ... the parties' resources, ... and the importance of the discovery in resolving the issues.

Rule 45(c) provides, in pertinent part, that upon a timely motion, a court must quash or modify a subpoena that "requires disclosure of privileged, or other protected matter, if no exception or waiver applies," or if it "subjects a person to undue burden." Fed. R. Civ. P. 45(c)(3)(A)(iii)(iv).

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[2] The Court sets forth the deposition topics and requests for production as an appendix to this Order.

[3] Movants acknowledge that relevance is interpreted broadly for purposes of discovery. *See, e.g., Phoenix Solutions Inc. v. Wells Fargo Bank, N.A.*, 254 F.R.D. 568, 583 (N.D. Cal. 2008).

[4] Unless otherwise noted, all further citations or references to rules are to the Federal Rules of Civil Procedure.

B. The Scope of the Requests.

Movants argue that the requests as drafted are overly broad. The discovery in question pertains to Plaintiffs' claims for damages. "[W]hen determining the amount of statutory damages to award for copyright infringement, courts consider," *inter alia*, "the infringer's state of mind...." *Bryant v. Media Right Productions, Inc.*, 603 F.3d 135, 144 (2d Cir. 2010). The Court has considered Movants' status as non-parties to the Lime Wire litigation and has considered whether the requested information is reasonably calculated to lead to the discovery of admissible evidence of the Lime Wire Entities' and Mr. Gorton's states of mind.

In request for production ("RFP") 1, 3-4, 6 and 8 Plaintiffs request that EFF and von Lohmann produce, and be deposed about, "communications between" EFF or von Lohmann and the Lime Wire entities or Gorton "relating to" various topics. (Scherb Decl., Ex. A at 2, 7-8, Ex. B at 5-6.) In RFPs 2, 5 and 7, Plaintiffs seek documents "reflecting or referring to" various topics. (*Id.*, Ex. A at 7-8, Ex. B at 5-6.) Movants do not argue that any of substantive topics are irrelevant to the issue of damages. In addition, in their response to Plaintiffs' sur-reply, Movants do not suggest that the amended subpoenas should be limited to the time period between January 1, 2005 through the present.

It appears from the record that the parties have reached an agreement whereby Mr. von Lohmann will produce responsive, non-privileged documents that "constitute" or "refer to" communications between EFF or Mr. von Lohmann and the Lime Wire Entities with respect to all eight RFPs. (Movants' Opening Supp. Br. at 2:19-21; Supplemental Declaration of Susan Boyd ("Boyd Supp. Decl."), ¶ 12.).) Accordingly, each of the RFPs directed to Mr. von Lohmann shall be so limited. Movants shall include documents dating from January 1, 2002 through the present in their production.

During the meet and confer process, Plaintiffs offered to limit each of the RFPs as to EFF to non-privileged documents that "constitute or refer to" communications between EFF employees and the Lime Wire Entities or Mr. Gorton. (*See* Boyd Supp. Decl., ¶ 12.) EFF argues that the requests directed to it should be further limited to documents that "constitute" communications between Movants and the Lime Wire Entities or Mr. Gorton. (*See, e.g.*, Movants' Supplemental Brief at 4 (noting that Movants offered to search documents of EFF employees for documents constituting "direct communications" with the Lime Wire Entities).) The Court finds EFF's arguments persuasive. In light of Mr. von Lohmann's concessions, the Court concludes that the burden of requiring EFF to search for and review documents that merely "refer to" communications with the Lime Wire Entities or Mr. Gorton, outweighs the likely benefits of production and Plaintiffs' need for such communications.

Accordingly, each of the RFPs directed at EFF shall be limited to require production of documents that "constitute" communications between EFF and the Lime Wire Entities or Mr. Gorton. Movants shall include documents dating from January 1, 2002 through the present in their production. The Court addresses the issue of the "Pho" list serve in the following section.

C. The "Pho" List.

One source for documents that may be responsive to Plaintiffs' RFPs is the "Pho" listserv, which plaintiffs describe as a "public distribution list with a large membership list." (Movants Opening Supp. Br. at 6:5.) According to the record, Mr. von Lohmann has approximately 24,000 email from the Pho listserv, that were sent to his personal email address, and another EFF attorney has approximately 23,000 emails from the Pho listserv. (*See* Declaration of Fred von Lohmann In Support of Movants' Opening Supp. Br., ¶ 3; Declaration of Corynne McSherry In Support of Movants' Opening Supp. Br., ¶ 4.)

Movants propose to treat emails sent to the Pho listserve like any other email, that is "if Lime Wire is actually a party to the email (*i.e.* if a Lime Wire domain appears in an address field or if a Lime Wire employee whom Movants otherwise communicated with appears in one of the address fields), Movants will review the document and produce it if it is responsive and non-privileged." (Movants Opening Supp. Br. at 8:6-10.) Plaintiffs agree, in part, to this proposal. (*See* Plaintiffs' Reply Supp. Br. at 4:13-5:2.) Plaintiffs do argue that any searches should not be limited to communications sent to a Lime Wire domain.

In light of the large number of emails identified by both Mr. von Lohmann and the EFF that involve the "Pho" listserv, and in light of the expanded time period involved, the Court finds it would pose an undue burden to require Movants to search for documents from the Pho listserve beyond those for which a Lime Wire domain appears in an address field or if a Lime Wire employee whom Movants otherwise communicated with appears in one of the address fields. Accordingly, the Court adopts Movants' proposal, and the scope of the production of emails from the Pho listserv shall be limited in that fashion.

D. The Privilege Issue and Privilege Log.

Originally, Movants primary argument in support of their motion to quash was that the RPFs called for them to disclose privileged information. The Court ordered EFF and Mr. von Lohmann to submit additional declarations setting forth whether non-privileged documents that were responsive to the subpoenas existed. According to Movants' supplemental declarations, they do. (*See* Supplemental Declaration of Cindy Cohn ("Cohn Supp. Decl."), ¶ 2; Supplemental Declaration of Fred von Lohmann ("von Lohmann Supp. Decl."), ¶ 4; Supplemental Declaration of Mark Gorton ("Gorton Supp. Decl."), ¶ 2.) In light of this concession and Plaintiffs concession that Movants would not be required to produce documents that are, in fact, privileged, the Court denies as moot this aspect of the motion to quash.

Although the issue of whether the motion to quash should be granted on the basis of privilege has been rendered moot, the parties were not able to agree on the issue of whether Movants should be required to provide a privilege log and, if so, the scope of the communications that must be logged. To the extent EFF or Mr. von Lohmann will be withholding documents on the basis of a privilege, Rule 45(d) requires a privilege log. Accordingly, they shall produce a privilege log with regard to those documents. If Mr. von Lohmann has documents that "refer to" communications between EFF or Mr. von Lohmann and the Lime Wire Entities with respect to all eight RFPs which are privileged communications with other clients, he shall include those documents on the privilege log.

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E. Depositions.

Because the Court has not quashed the subpoenas, a Rule 30(b)(6) designee from EFF and Mr. von Lohmann shall appear for deposition. However, the limitations set forth above regarding the RFPs also shall apply to the scope of testimony taken during depositions. This Court is unavailable between December 27 and December 31, 2010. Based on the history of this litigation, the Court anticipates that disputes will arise during the course of the depositions. Therefore, it is HEREBY ORDERED that the parties shall not commence the depositions before January 3, 2011. The Court HEREBY REFERS the parties to its Standing Order on Depositions, which sets forth the Court's expectations about the manner in which depositions shall be conducted.[5] The parties are specifically referred to paragraph 9, which provides:

> If a dispute arises during a deposition and involves a persistent obstruction of the deposition or a refusal to answer a material question on the basis of any ground other than privilege or the work product doctrine, counsel may arrange a telephonic conference with the Court through Chambers at (415) 522-4160. Any such conference shall be attended by the court reporter recording the deposition.

F. Protective Order.

Movants also ask the Court to "enter a protective order limiting disclosure to a single counsel of record for [Plaintiffs] with respect to these subpoenas, Susan Boyd," because the EFF is opposing counsel to Plaintiffs' counsel, Munger, Tolles and Olson in unrelated copyright litigation. (*See* Movants' Opening Supp. Br. at 14:5-13.) Plaintiffs respond that the Protective Order that has been entered in the *Lime Wire* Action is adequate to protect any documents produced by EFF and Mr. von Lohmann. (Plaintiffs' Supp. Reply Br. at 8:14-28, Ex. A.) The Court agrees with Plaintiffs on this issue. If, however, as events unfold Movants believe additional protection is necessary, they may seek leave of this Court to revisit the issue.

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[5] The Court recognizes that, in this case, the parties may not be able to comply with the following provision of paragraph 6: "Witnesses subpoenaed to produce documents should ordinarily be served at least 30 days before the scheduled deposition and arrangements should be made to permit inspection of the documents before the deposition commences."

G. Movants Are Entitled to Reasonable Costs.

Rule 45 provides that "[a] party or attorney responsible for issuing and serving a subpoena must take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena. The issuing court must enforce this duty and impose an appropriate sanction – which may include lost earnings and reasonable attorney's fees – on a party or attorney who fails to comply." Fed. R. Civ. P. 45(c)(1). "Although party witnesses must generally bear the burden of discovery costs, the rationale for the general rule is inapplicable where the discovery demands are made on non-parties. Nonparty witnesses are powerless to control the scope of litigation and discovery, and should not be forced to subsidize an unreasonable share of the costs of a litigation to which they are not a party." *United States v. Columbia Broadcasting Syst., Inc.*, 666 F.2d 364, 371 (9th Cir. 1982).

Although it has not granted Movants' request to quash the subpoenas outright, and although Movants and Plaintiffs were able to reach some accommodation *after* the Court ordered them to meet and confer, the Court has further modified the discovery requests in order to reduce the burden placed upon EFF and Mr. von Lohmann. Plaintiffs, in turn, have increased the time period involved by three years. Accordingly, the Court concludes that Movants are entitled to *reasonable* costs associated with searching for, reviewing and producing the documents, including creating any necessary privilege logs, and in connection with the depositions. Movants shall submit a request to the Court for those costs after the document production and depositions are complete. Plaintiffs may file a response fourteen days thereafter, and Movants may file a reply seven days after Plaintiffs have filed their response.

CONCLUSION

For the foregoing reasons, the Court hereby GRANTS IN PART AND DENIES IN PART the motion to quash. This Order terminates Dockets 1, 22, and 28.

IT IS SO ORDERED.

Dated: December 17, 2010

JEFFREY S. WHITE
UNITED STATES DISTRICT JUDGE

APPENDIX

Deposition Topics

1. Communications between EFF and the Lime Wire Entities or Gorton relating to the retention or destruction of documents, including without limitation communications regarding a document retention policy or program.

2. EFF's knowledge, understanding or analysis of the actual or potential use of Lime Wire to share copyrighted materials.

3. Communications between EFF and the Lime Wire Entities or Gorton relating to the actual or potential use of Lime Wire to share copyrighted materials.

4. Communications between EFF and the Lime Wire Entities or Gorton relating to the actual or potential tracking or monitoring of downloads by users of Lime Wire or other peer-to-peer file sharing networks.

5. Communications between EFF and the Lime Wire Entities or Gorton relating to the architecture, design, or structure of Lime Wire or other peer-to-peer file sharing networks.

6. Communications between EFF and the Lime Wire Entities or Gorton relating to infringement-reducing technologies, including without limitation filtering or acoustic-fingerprinting technologies.

7. Communications between EFF and the Lime Wire Entities or Gorton relating to actual or anticipated litigation by copyright holders.

Requests for Production of Documents to EFF.

1. All documents relating to communications between EFF and the Lime Wire Entities or Gorton relating to the retention or destruction of documents, including without limitation communications regarding a document retention policy or program.

2. All documents reflecting or referring to the actual or potential use of Lime Wire to share copyrighted materials.

3. All documents relating to communications between EFF and the Lime Wire Entities or Gorton relating to the actual or potential tracking or monitoring of downloads by users of Lime Wire or other peer-to-peer file sharing networks.

4. All documents relating to communications between EFF and the Lime Wire Entities or Gorton relating to the architecture, design, or structure of Lime Wire or other peer-to-peer file sharing networks.

5. All documents reflecting or referring to the Lime Wire Entities' or Mark Gorton's state of mind, purpose, or motivation for adopting or not adopting particular architectures, designs, structures or features for Lime Wire.

6. All documents relating to communications between EFF and the Lime Wire Entities or Gorton relating to infringement-reducing technologies, including without limitation filtering or acoustic-fingerprinting technologies.

7. All documents reflecting or referring to the Lime Wire Entities' or Mark Gorton's state of mind, purpose, or motivation for adopting or not adopting infringement-reducing technologies, including without limitation filtering or acoustic-fingerprinting technologies.

8. All documents relating to communications between EFF and the Lime Wire Entities or Gorton relating to actual or anticipated litigation by copyright holders.

Requests for Production of Documents to Mr. von Lohmann.

1. All documents relating to communications between Fred von Lohmann or EFF and the Lime Wire Entities or Gorton relating to the retention or destruction of documents, including without limitation communications regarding a document retention policy or program.

2. All documents reflecting or referring to the actual or potential use of Lime Wire to share copyrighted materials.

3. All documents relating to communications between Fred von Lohmann or EFF and the Lime Wire Entities or Gorton relating to the actual or potential tracking or monitoring of downloads by users of Lime Wire or other peer-to-peer file sharing networks.

4. All documents relating to communications between Fred von Lohmann or EFF and the Lime Wire Entities or Gorton relating to the architecture, design, or structure of Lime Wire or other peer-to-peer file sharing networks.

5. All documents reflecting or referring to the Lime Wire Entities' or Mark Gorton's state of mind, purpose, or motivation for adopting or not adopting particular architectures, designs, structures or features for Lime Wire.

6. All documents relating to communications between Fred von Lohmann or EFF and the Lime Wire Entities or Gorton relating to infringement-reducing technologies, including without limitation filtering or acoustic-fingerprinting technologies.

7. All documents reflecting or referring to the Lime Wire Entities' or Mark Gorton's state of mind, purpose, or motivation for adopting or not adopting infringement-reducing technologies, including without limitation filtering or acoustic-fingerprinting technologies.

8. All documents relating to communications between Fred von Lohmann or EFF and the Lime Wire Entities or Gorton relating to actual or anticipated litigation by copyright holders.